

### **REMARKS**

Upon entry of this Preliminary Amendment, claims 1-32 remain pending in this application. Claims 24-32 are newly added. It is believed that the foregoing amendments add no new matter to the present application.

### **RESPONSE TO REJECTIONS UNDER 35 U.S.C. §103**

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). In addition, “(t)he PTO has the burden under section 103 to establish a *prima facie* case of obviousness.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Furthermore, the Federal Circuit has stated that “(i)t is impermissible, however, to simply engage in hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.” *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (1991).

**Claim 1**

In the Office Action mailed May 27, 2003, claim 1 stands rejected under 35 U.S.C. §103 as purportedly being unpatentable over *Mori* in view of *Housel*. Claim 1 reads as follows:

1. A method for printing information comprising:  
storing information corresponding to a print task in memory in a print-ready format, the information in the print-ready format being configured for use by a printing device such that the information can be printed by the printing device without being processed by a driver of the printing device; and  
***enabling a selected portion of the information in print-ready format to be printed without printing a non-selected portion of the print task.*** (Emphasis added).

Applicant respectfully asserts that the cited art is inadequate to render pending claim 1 obvious. In particular, the cited art fails to suggest or teach at least the features of pending claim 1 highlighted hereinabove.

The Office Action states that “*Mori* does not specifically teach ...[a] job retention system... configured to enable the selected portion of the print-ready information to be printed without printing a non-selected portion of the print-ready information.” See Office Action, page 2. However, the Office Action asserts that *Housel* does teach a printing system exhibiting this feature, and Applicant respectfully traverses this assertion.

In this regard, *Housel* appears to generally teach a printing system that permits a user to select portions of a print task to be printed on selected mediums. However, it does not appear that the print task is “information in print-ready format.” To the contrary, *Housel* specifically teaches allowing a user to select print task pages and



associated mediums at the printer interface, and thereafter, the “central processing unit 17 converts the information ...into printer-readable language for the printer.” See *Housel*, paragraph 52, lines 5-10.

Therefore, Applicant asserts that neither *Mori* nor *Housel* teaches or suggests “enabling a selected portion of the *information in the print-ready format* to be printed without printing a non-selected portion of the information in the print-ready format,” as claimed in claim 1. (Emphasis added). Accordingly, Applicant submits that the Office Action fails to overcome its burden of establishing that each of the combination of features highlighted hereinabove for claim 1 is suggested or taught by the cited art.

For at least the foregoing reasons, Applicant submits that the 35 U.S.C. §103 rejection of claim 1 is improper and should be withdrawn.

### **No Motivation to Combine**

In addition, in rejecting pending claim 1, it is asserted in the Office Action that:

“[I]t would have been obvious to one having ordinary skill in the art to modify *Mori* to permit portions of the print-ready information to be selected and printed since *Housel et al.* teaches that enabling a selected portion of a print job to be printed is beneficial for permitting a user to more easily designate the print jobs.”

However, Applicant respectfully asserts that this alleged motivation for combining *Mori* with *Housel* is inadequate.

In this regard, the Office Action fails to cite a specific teaching in the cited art showing that the alleged motivation for combining *Mori* with *Housel* is suggested by the cited art. “There must be some reason, suggestion, or motivation *in the prior art* whereby a person of ordinary skill in the field of the invention would make the combination.” *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443 (Fed. Cir.

1992)(emphasis added). Moreover, Applicant submits that the aforementioned reason proffered in the Office Action for combining *Mori* with *Housel* is not gleaned from the cited art but is instead based on improper hindsight reconstruction of Applicant's invention. As a result, the combination of *Mori* and *Housel* to reject pending claim 1 under 35 U.S.C. §103 is improper.

### **Claims 2-9 and 21-29**

Claims 2-9 and 21-29 are also not patentable under 35 U.S.C. §103 over *Mori* in view of *Housel*. Applicant submits that the pending dependent claims 2-9 and 21-29 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-9 and 21-29 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **Claim 10**

Claim 10 presently stands rejected under 35 U.S.C. §103 as purportedly being unpatentable over *Mori* in view of *Housel*. Previously presented claim 10 reads as follows:

10. A print system comprising:  
a job retention system configured to receive an input corresponding to a selected portion of print-ready information and retrieve the print-ready information corresponding to the selected portion, the information being in a print-ready format configured for use by a printing device such that the information can be printed by the printing device without being processed by a driver of the printing device, *the job retention system being further configured to enable the selected portion of the print-ready information to be printed without printing a non-selected*

*portion of the print-ready information.* (Emphasis added).

For at least the reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant submits that the cited art fails to suggest or teach at least the features of claim 10 highlighted hereinabove. Therefore, the 35 U.S.C. §103 rejection of claim 10 is improper and should be withdrawn.

### **Claims 12-20 and 30**

Claims 12-20 and 30 are not obvious under 35 U.S.C. §103 over *Mori* in view of *Housel*. Applicant submits that the pending dependent claims 12-20 and 30 contain all features of their respective independent claim 10. Since claim 10 should be allowed, as argued hereinabove, pending dependent claims 12-20 and 30 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **Claim 31**

Claim 31 is newly added and reads as follows:

31. A system, comprising:  
a printing device having an input interface; and  
a job retention system configured to receive and store print-ready information corresponding to a print task, the job retention system further configured to receive selection information from a user, via the input interface, and configured to select a portion of the print-ready information based upon the selection information, the job retention system further configured to enable the selected portion of the print-ready information to be printed without printing a non-selected portion of the print-ready information.

Applicant asserts that the cited art fails to disclose or teach each of the above features of claim 31. Thus, claim 31 is allowable.

### Claims 32

Claim 32 is newly added and depends from claim 31. Applicant submits that the pending dependent claim 32 contains all features of its respective independent claim 31. Since claim 31 should be allowed, as argued hereinabove, pending dependent claim 32 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted ,

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